

REMARKS

The Office Action mailed on June 06, 2005, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-20 were pending. By this paper, Applicants cancel claims 2-11 and 13-20, and add claims 21-40. Therefore, claims 1, 12 and 21-40 are now pending.

Applicants respectfully submit that the method claims are similar enough to the apparatus claims that the burden on the PTO of considering the patentability of these method claims, in addition to the apparatus claims, would be minimal.

Applicants respectfully submit that the present application is in condition for allowance for at least the reasons that follow.

Information Disclosure Statement of February 17, 2005

Applicants understand that the February 17, 2005 Information Disclosure Statement does not comply with various provisions of the MPEP and the CFR. The Information Disclosure Statement was for another application, and was filed in error in this case. Applicants thus submit that the issues relating to the February Information Disclosure Statement are moot with respect to this application.

Indication of Allowable Subject Matter

Applicants thank Examiner Salvatore for the indication that claim 12 contains allowable subject matter. Applicants have placed this claim into independent form.

Claim Rejections Under 35 U.S.C. §103(a)

In the Office Action, Claims 1-2, 6-15 and 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Adriaensen (WO 98/55682) in view of Zheng (U.S. Patent No. 5,807,430), while claims 1-2, 4-5, 7-15 and 17-20 are rejected as obvious in view of Adriaensen when combined with Czerwinski (U.S. Patent No. 4,308,365), while claims 1-3, 7-15 and 17-20 are rejected as obvious in view of Adriaensen when combined with Daisel (JP 5216465). Further, claim 16 stands rejected under the same statute in view of Adriaensen when combined with any of Zheng, Czerwinski and Daisel, in further combination with Carey II (USP 5,489,490).

As a preliminary matter, Applicants assume that the rejection of claim 12 was in error, as section 8 of the Office Action states that claim 12 would be allowable if rewritten in independent form, because the prior art does not teach or fairly suggest the invention of claim 12.

In response to the rejections, in order to advance prosecution, Applicants amend claim 1 and cancel claims 2-11 and 13-20 as seen above, and add new claims 21-40. Applicants respectfully submit that the currently pending claims are allowable for at least the following reasons.

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that none of these criteria of MPEP § 2143 can be met with regard to the cited references as applied to at least the currently pending claim set.

The Cited References Do Not Suggest All Claim Recitations

Even if the first and second requirements of MPEP § 2143 were able to be satisfied in with the cited references (which they are not, as explained below), the cited references still do not meet the third requirement, even after combination, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Each of the independent claims recite either the action of welding strips as claimed to a plastic coated canvass, or a canvass assembly with strips as claimed welded to a plastic coated canvass. The cited references, even after combination, do not disclose or suggest such features. Therefore the third requirement of MPEP § 2143 cannot be satisfied with these references, since the cited references, alone or in combination, do not teach or suggest each and every element of any pending claim.

Lack of Suggestion or Motivation to Modify or Combine the References

As a preliminary matter, Applicants traverse the allegation that there was sufficient motivation to modify the cited references to arrive at the invention of any of the prior pending claims. The Office Action asserts that because Adriaensen teaches that wires are less expensive than cords, it would have been obvious to utilize wires in Adriaensen, even though, Adriaensen specifically teaches away from the use of wires by detailing the drawbacks to using wires, and instead teaches the use of cords.

Applicants emphatically traverse this economic motivation argument. Applicants submit that simply because a particular combination is less-expensive, it does not automatically become obvious. Indeed, when the prior art teaches/suggests that a feature may be desirable due to economic reasons, but then completely teaches away from this feature due to the level of skill in the art at the time, as is the case here, this is evidence that the combination is not obvious.

In view of the above, Applicants point to MPEP § 2144.05(III), entitled Rebuttal Of *Prima Facie* Case Of Obviousness, which states that a “*prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” (MPEP § 2144.05(III), second paragraph, emphasis added, citations

omitted.) Applicants respectfully submit that to the extent that a *prima facie* case of obviousness of the invention of former claim 1 has been made, that case has been rebutted under MPEP § 2144.05(III), in view of the fact that Adriaensen specifically teaches away from the invention of claim 1.

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As noted above, no cited reference teaches welding a strip as claimed to a canvass coated with plastic. There is no suggestion of doing this in the cited references as well, and Adriaensen teaches away from such an action. As is specifically detailed at page 3, lines 1-11 of the specification, the invention of the pending claims permits the strips to be welded to the canvass while limiting the amount of thermoplastic material that flows away during welding. If too much material flows away, the metal member will no longer be surrounded by the thermoplastic material after welding, resulting in increased susceptibility to corrosion of the metal. The ordinary artisan would have thus been discouraged from welding the strips of Adriaensen, which does not utilize primer, to canvass because the thermoplastic of those strips would flow away in large quantities during welding, thus exposing the underlying metal to corrosion. Adriaensen, for at least this reason, teaches away from the inventions as claimed.

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Applicants maintain their position with respect to the lack of motivation to modify the cited references proffered in their Response of February 17, 2005, those positions being incorporated herein by reference in their entirety.

In summary, because of the lack of suggestion or motivation in the prior art to modify the references, the first requirement of MPEP § 2143 was not met with respect to the previously pending claims, and cannot be met with respect to the present claims, hence, a *prima facie* case of obviousness has not and cannot be established.

Lack of a Reasonable Expectation of Success

MPEP § 2143.02 permits references to be modified or combined to reject a claim as obvious only if there is a reasonable expectation of success. As detailed above, the invention as claimed permits a reinforced canvass assembly to be manufactured without incurring significant thermoplastic flow away from the strips during welding of the strips to the plastic coated canvass. The skilled artisan would have believed that if an attempt was made to weld the strips of Adriaensen to a canvass, a significant amount of thermoplastic material would flow from the strips, leaving exposed portions of the underlying metal, thus resulting in a canvass assembly susceptible to corrosion, as well as strips that are not sufficiently welded to the canvass. Thus, the skilled artisan would not have had a reasonable expectation of successfully applying the strips of Adriaensen to a canvass as claimed.

In view of the above, the second criteria of MPEP § 2143 cannot be met with the cited references, and thus a *prima facie* case of obviousness cannot be established.

Substance of Interview Statement

In view of the telephone interview held on August 15, 2005, Applicants submit that the following is a complete and proper recordation of the substance of the interview, per MPEP § 713.04: Applicants' representative inquired about the possibility of filing a Declaration attesting to the fact that Adriaensen discourages the ordinary artisan from arriving at the invention as claimed, and Examiner Salvarore indicated that such a declaration would not be considered due to the finality of the Office Action and that such a declaration might not be persuasive.

In view of the telephone interview held on August 31, 2005, Applicants submit that the following is a complete and proper recordation of the substance of the interview, per MPEP § 713.04: Applicants' representative inquired about whether an RCE would be required to enter the above claim amendments, and Examiner Salvarore indicated that an RCE would be required, and, moreover, that the method claims might be restricted out of the application.

Conclusion

Applicants believe that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Salvatore is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

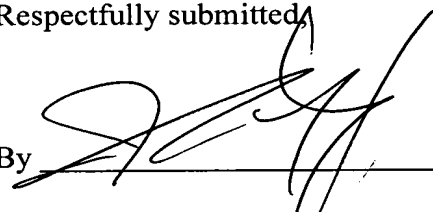
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